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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,101	12/11/2000	Benoit Ambroise	10244	3915
23455	7590	12/05/2003	EXAMINER	
EXXONMOBIL CHEMICAL COMPANY			VO, HAI	
P O BOX 2149			ART UNIT	PAPER NUMBER
BAYTOWN, TX 77522-2149			1771	

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,101

Applicant(s)

AMBROISE ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 4 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Taskier (US 3,853,601) substantially as set forth in the Office Action mailed on 05/21/2003. Applicants argue that the hydrophilic film of Taskier is incapable of being used for ink jet printing and does not absorb ink at all because the hydrophobic film of Taskier has a pore size sufficiently small to bar the flow of ions but large enough to allow the flow therethrough of electrons. The arguments are not found persuasive. Taskier discloses the film having a pore size of 100 to 12000 angstroms or 0.01 to 1.2 microns within the claimed range (column 3, line 49). Likewise, the film of Taskier absorbs the ink too. Additionally, the film of Taskier meets all the structural limitations and chemistry as recited in the claims; i.e., a porous high density polyethylene surface layer and a surfactant coating of a silicon glycol

copolymer wherein the porous surface layer has a pore size within the claimed range and a net work of interconnecting pores communicating throughout the surface layer. Therefore, it is not seen that the film of Taskier would have been performed differently from that of the present invention with respect in ink absorption. Accordingly, the ink absorption would have been inherently present. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.

With regard to claims 3 and 9, they should be included in the art rejections over Taskier (US 3,853,601) as set forth in the Office Action mailed on 05/21/2003. Taskier discloses that the porosity of the film is improved when the film is treated with perchloroethylene (column 5, lines 30-36). Likewise, the perchloroethylene acts as a cavitating agent. Nothing in Taskier discloses or suggests the microporous film made of high molecular weight polyethylene (column 7, lines 50-65).

4. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskier (US 3,853,601) as applied to claim 1, in view of Lundquist et al (US 4,731,304). Taskier does not specifically disclose the biaxially oriented film comprising a core layer coextruded with the microporous film. Lunquist teaches a microporous film comprising a matrix that includes porous high density polyethylene, a net work of interconnecting pores communicating throughout the porous layer and a calcium carbonate cavitating agent (column 7, lines 8-10, 43

and column 10, lines 60-66). Lunquist teaches a battery separator comprising at least two microporous films bonded together by extrusion to form a unitary structure which is capable of maintaining its length and breath dimensions (column 3, lines 5-10, and column 10, lines 30-40). Such is important to the invention of Taskier, thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to laminate the microporous film of Taskier onto the microporous film of Lunquist motivated by the desire to form a unitary structure which is capable of maintaining its length and breath dimensions.

5. The art rejections over Waller in combination with Mrozinski, Topolkraev, Emslander, Anderson and Topolkaraev have been overcome by the present arguments (page 7 of the amendment received on 08/21/2003). Table I of Applicants' specification has shown that the inclusion of the binder which is required in Waller hinders the ability of the silicone glycol coating to promote drying of ink applied to the coated film.

Allowable Subject Matter

6. Claims 4 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The inclusion of the calcium carbonate in the porous surface layer as define in claim 1 renders it patentable over the prior art. The inclusion of the non-porous skin layer co-extruded to the core layer on the opposite side of the core layer from the porous

high density polyethylene HDPE surface layer is structurally distinguished from the prior art.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER